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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,446	01/28/2004	Douglas G. Vanderlaan	VTN5537DIV	3191

27777 7590 08/02/2005

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EXAMINER
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PENG, KUO LIANG

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 08/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/766,446

Applicant(s)

VANDERLAAN ET AL.

Examiner

Kuo-Liang Peng

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 6/6/05 Amendment.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21, 23 and 75-80 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21, 23 and 75-80 is/are rejected.
- 7) ☒ Claim(s) 76 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The Applicants' amendment filed on June 6, 2005 was received. Claims 22 and 24-74 are deleted. Claims 1, 7-8, 18, 21 and 75-76 are amended. Now, Claims 1-21, 23 and 75-80 are pending.

2. Claim objection(s) in the previous Office Action (Paper No. 1204) is/are removed.

3. Claim rejection(s) under 35 USC 112 in the previous Office Action (Paper No. 1204) is/are removed.

4. The indicated allowability of Claims 12-21 and 23 and 79-80 is withdrawn in view of the newly discovered reference(s) to Vanderlaan (US 5 998 498).

Rejections based on the newly cited reference(s) follow. Examiner apologies for causing any inconvenience.

5. The text of those sections of Title 35, U.S. code not included in this action can be found in a prior Office Action (Paper No. 1204).

### ***Claim Objections***

6. Claim 76 is objected to because of the following informalities:

In Claim 76 (line 3), should “of claim 1” be removed because the mono-alkyl terminated polydiorganosiloxane now refers to the one in Claim 75?

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-11, 13-21, 23 and 75-78 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 1 (lines 2-3) and Claim 75 (lines 2-3), it is not clear as to what “less than about 0.1 to no more than about 0.3” refers to.

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to

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prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-21, 23 and 75-80 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 9-11 of U.S. Patent No. 5 998 498. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reason: Claims 9-11 of US 5 998 498 discloses the use of a composition that reads on the instant claims. Although US 5 998 498 is silent on the resulting properties derived from the composition, Applicants admit in the specification of the present invention (page 7, last paragraph) that a composition comparable to that of US 5 998 498 would obviously possess the properties recited in the instant claims in the present invention.

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11. Claims 1 and 75 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph and/or double patenting rejection, set forth in this Office action.

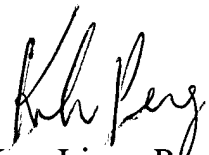
Spinelli (US 5 314 960) does not teach a method which lowers the Young's modulus or  $\tan \delta$  to the specific range set forth in the instant claims. Especially, it is noted that the specific ranges of the Young's modulus and  $\tan \delta$  are not inherent properties of any composition that is derived from a monomer mixture comprising the aforementioned (meth)acryl-containing silicone monomer. The Young's modulus and  $\tan \delta$  depend on the relative amounts and characteristics of other monomers too. Furthermore, Spinelli does not even recognize the importance of Young's modulus or  $\tan \delta$ . Therefore, there is no motivation for one of ordinary skill in the art to optimize the Young's modulus or  $\tan \delta$  based on the Spinelli's teaching. In light of which, Spinelli does not fairly suggest the specific ranges of the Young's modulus and  $\tan \delta$  set forth in the present invention.

12. Claims 2-21, 23 and 76-80 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, double patenting rejection and/or claim objection, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp  
July 29, 2005

  
Kuo-Liang Peng  
Primary Examiner  
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